

II. REMARKS

The Office Action dated August 21, 2006, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto.

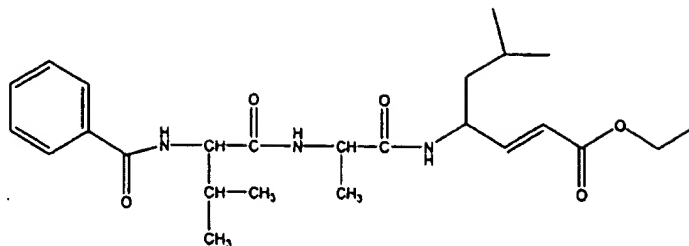
Claims 23-25, 27, 29, 31-66, 68-78 are pending in the present application. Claims 24, 27, 29, 34, 36, 59, 60, 62, and 74 are withdrawn from consideration by the Examiner, and Applicants reserve the right to file one or more divisional applications to the subject matter of the withdrawn claims. Applicants thank the Examiner for indicating that claims 35, 37-58, 61, 63-66 and 68-72 are allowable.

At this time, claims 31 and 75 are amended. Support for the claim amendments can be found in the specification and claims as originally filed. In particular, Applicants assert that claim 31 is amended to optimize the Markush group, and claim 75 is amended to further clarify the scope of the claim. Therefore, Applicants believe that no new matter is added.

Rejection under 35 U.S.C. § 102(a) over Johnson et al.

Claims 23, 25, 31-33, 73 and 76 are rejected under 35 U.S.C. § 102(a) over Johnson et al. (WO 97/04004). Applicants traverse the rejection.

As noted by the Examiner, Applicants submit that Johnson et al. discloses the following compound:



wherein, corresponding to the present invention, R₁ is benzoyl, R₂ is hydrogen (H), R₃ is methyl, R₄ is methyl, and R₅ is hydrogen (H) (Johnson et al., compound 26, page 74).

Applicants submit that claims 23, 25, 31-33, 73 and 76 are not taught or suggested by Johnson et al. For example, in contrast to Johnson et al., claims 23, 25, and 73 of the presently claimed invention each explicitly indicate that “if either one of R₁ and R₂ is H, each of R₃, R₄, R₆ and R₈ are H.” In other words, Applicants submit that in claims 23, 25, and 73, when either R₁ or R₂ is hydrogen (H), then R₃ and R₄ are not methyl. As noted above, in Johnson et al., the corresponding R₃ and R₄ are both methyl.

Further, Applicants submit that present claim 31 and dependent claims 32 and 33 recite that “provided that where one of R₁ or R₂ is H, the other is not benzoyl.” As noted above, in Johnson et al., the corresponding R₁ is benzoyl, R₂ is hydrogen. Applicants also submit that claim 33 recites that R₅ is Ar, while in Johnson et al., the corresponding R₅ is hydrogen.

Applicants submit that claim 76 recites that “R₁ and R₂ are independently selected from the group consisting of: H, methyl, ethyl, propyl and n-butyl” (emphasis added). As noted above, Applicants submit that in the cited compound of Johnson et al., the corresponding R₁ is benzoyl and therefore is not hydrogen, methyl, ethyl, propyl, or n-butyl.

As such, as Johnson et al. fails to teach or suggest all of the elements of the presently claimed invention, Applicants respectfully request withdrawal and reconsideration of the rejection of claims 23, 25, 31-33, 73 and 76 under 35 U.S.C. § 102(a) over Johnson et al.

Rejection under 35 U.S.C. § 102(b) over Falendar et al.

Claim 23 is rejected under 35 U.S.C. § 102(b) over Falendar et al. (Biocatalysis and Biotransformation, 13(2), 131-139 (1995)). Applicants traverse the rejection.

As noted by the Examiner, Applicants submit that Falender et al. discloses the following compound:



wherein, corresponding to the presently claimed invention, R₂ is hydrogen and R₃ is phenyl.

In contrast, Applicants submit that claim 23 of the presently claimed invention discloses that "if either one of R₁ and R₂ is H, each of R₃, R₄, R₆ and R₈ are H" (emphasis added). In other words, Applicants submit that in claim 23 of the presently claimed invention, when R₂ is hydrogen, R₃ is hydrogen, not phenyl.

As such, as Falendar et al. does not teach or suggest all of the elements of the presently claimed invention, Applicants request reconsideration and withdrawal of the rejection of claim 23 under 35 U.S.C. § 102(b) over Falendar et al.

Rejection under 35 U.S.C. § 102(e) over Eisenbach-Schwartz

Claims 75, 77, and 78 are rejected under 35 U.S.C. § 102(e) over Eisenbach-

Schwartz et al. (U.S. Patent No. 6,126,939). Applicants traverse the rejection.

Applicants submit that Claim 75 is directed to a compound in which “Y is a linear, unsaturated, two to six carbon alkyl group, optionally substituted with phenyl, naphthyl, anthracyl, phenanthryl or a saturated or unsaturated moiety having a linear, branched, or non-aromatic cyclic skeleton consisting of one to ten carbon atoms optionally substituted with: =S, -OH.”

In contrast, as noted by the Examiner, Applicants submit that Eisenbach-Schwartz et al. discloses a compound in which the group corresponding to Y of claim 75 is ethyl, which is not a “linear, unsaturated, two to six carbon alkyl group.”

Applicants disagree with the Examiner’s assertion that under a “reasonable interpretation” of claim 75, Y is a linear, unsaturated alkyl group, or Y is a saturated or unsaturated moiety. Applicants submit that claim 75 recites that Y is a linear, unsaturated alkyl group which may be optionally substituted with a number of groups, including a saturated or unsaturated moiety. However, in order to expedite prosecution and clarify the scope of the presently claimed invention, Applicants have amended claim 75 to recite that “Y is a linear, unsaturated, two to six carbon alkyl group, optionally substituted with:

- (a) phenyl,
- (b) naphthyl,
- (c) anthracyl,
- (d) phenanthryl, or
- (e) a saturated or unsaturated moiety...”

As such, as Eisenbach-Schwartz et al. fails to teach or suggest all of the

elements of the presently claimed invention, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 75, 77, and 78 under 35 U.S.C. § 102(e) over Eisenbach-Schwartz et al.

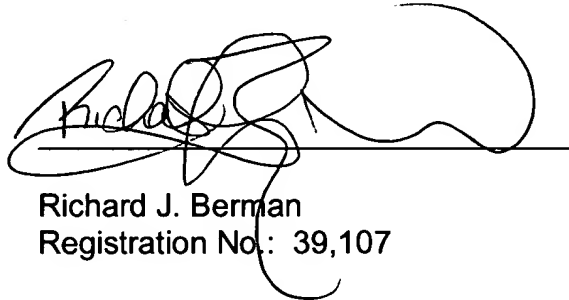
III. CONCLUSION

In view of the amendments and remarks above, Applicants respectfully submit that this application is in condition for allowance and request favorable action thereon. If the Examiner believes that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below to discuss any remaining issues.

Any additional fees that are required with respect to this response may be charged to Deposit Account No. 01-2300, referencing Attorney Docket No. **108281-00000**.

Respectfully submitted,

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RJB/YYK

Enclosure: Petition for Extension of Time (1 month)